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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,103	12/11/2001	Alex Mashinsky	5106-5	2650

7590 02/09/2007  
COHEN, PONTANI, LIEBERMAN & PAVANE  
551 Fifth Avenue, Suite 1210  
New York, NY 10176

EXAMINER
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BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/014,103

Applicant(s)

MASHINSKY ET AL.

Examiner

Jason M. Borlinghaus

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

**Claim 3** is objected to because of the following informalities: improper verb tense. Claim should state "further comprising a delivery system comprising a switching node" not "further comprising a delivery system comprises a switching node." (emphasis added).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 –34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US Patent 6,324,519) in view of Wagner (US Patent 4,903,201).

**Regarding Claims 1 - 2, 8, 15 – 20,** Eldering discloses a system for trading media space, comprising:

- a server node (server) operatively connectable to user interfaces for receiving a request for media space (advertising space/opportunities) from a buyer (advertisers) and offers of media space (advertising space/opportunities) from sellers (content providers), said server node (consumer profile server) comprising a set of rules (correlation operation) for matching (correlating) the request and the offer in accordance with a said set of rules. (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said server node (server) configured to facilitate delivery of media content (advertisement) between the matched (correlated) buyer (advertiser) and seller (content provider) in response to the executed trade (accepted bid). (see col. 1, lines 45 - 55);
- wherein said server node (server) is further configured for sending (transmitting) notice of the match (correlation results) to the matched buyer and seller. (see col. 10, lines 20 – 36).
- wherein said server node (server) is connectable to the buyers and the sellers via a wide area communication network (Internet). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein the media space is an ad space on one of television (broadcast video programming). (see col. 1, lines 38 – 44);

- wherein the media space includes attributes comprising at least on target market (demographics). (see col. 2, lines 11 – 14);
- wherein the buyer and seller are market participants, wherein the market participants comprise at least one of an advertiser (advertiser). (see fig. 1A); and
- wherein further comprising an interface (Internet) through which the buyer and seller interact with said server node, said interface comprising at least one of a computer. (see col. 8, line 40 – col. 9, line 5).

Eldering does not teach the inclusion of a deal execution requirement, the execution of a trade between matched parties in accordance with such requirement; notification of such executed trade nor activities related to finalizing the execution, such as clearing, settlement and billing for the executed trade. However, such activities are notoriously old and well known in the art of matching or trading systems.

Wagner discloses a system for trading wherein there is the inclusion of a deal execution requirement should a match between a buyers request and a sellers offer and the exercising of such an execution requirement (executes matching bids and offers), notification of such executed trade (notifies traders of filled or unfilled orders), and clears (executes and clears trades simultaneously), billing and transmission of information for further settlement (provides necessary trade data for settlement). (see col. 20, line 54 – col. 21, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering by incorporating such features, as

disclosed by Wagner, as such features and/or activities are conventional and standard in the operation of matching or trading systems.

Eldering does not teach the presentation an input screen to the buyer and seller for the request and the offer, although Eldering does teach the input of information by the buyer and seller into a computer system and generally computer systems operate with a screen or display.

Regardless, Wagner discloses an input screen for the buyer and seller to input their request and offer. (see fig. 19).

It would have been obvious to one of ordinary skill in the art to have modified Eldering and Wagner by incorporating an input screen, as disclosed by Wagner, allowing a visual interface to facilitate the inputting of data into the system, thereby increasing ease of use for the system.

**Regarding Claims 3 – 7**, Eldering discloses a system for trading media space further comprising:

- a delivery system (network) comprising a connection between said server node (customer profile server), a buyer's content database (ad server) and a seller's content database (content server), wherein the media content (advertisement) is delivered from the buyer's content database (ad server) to the seller's content database (content server) via said connection. (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said delivery system further comprises a contents database (ad server) connected to a network and configured to store media content

(variety of advertisements), the delivery system being configured to receive the media content from the buyer (advertiser) when the request (request for advertising space/opportunities) is submitted to the server node (server) and storing the media content (variety of advertisements) in the content database (ad server), and the delivery system being configured to deliver the media content (advertisement) from the content database (ad server) to the one of the sellers (content providers) of the matched (correlated) pair via the connection (network). (see abstract; fig. 1 and 7; col. 4, lines 8 – 11; col. 9, line 32 – col. 12, line 26);

- wherein said connection to said buyer's content database (ad server) and said seller's content database (content server) via a file transfer means (transport protocols). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said connection to said buyer's content database (ad server) and said seller content database (content server) via a file transfer means (transport protocols) consisting of one of an IP network (Internet) and e-mail system (e-mail messages). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26); and
- wherein said delivery system (network) further comprises a contents database (web site) connected to means for receiving and storing the offered media content (listing of advertising opportunities) from the seller (content provider) when the offer (advertising space/opportunities)

submitted to the server node (web site) and storing the offered media content (listing of advertising opportunities) in the contents database (web site), and means for delivering (Internet) the content media (advertisement) from the buyer (advertiser) to the seller (content provider) of the matched (correlated) pair.

Eldering does not teach the use of a third content database nor the use of a switching node.

As to the third content database, neither the combination of two databases into a third database (the third database being an amalgamation of the prior existing two) nor the creation of an additional third database (the third database operating in addition to the prior existing two database) make the claim limitation patentably distinct. In regards to the combination, The Courts have stated that forming in one piece an article that had formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965). In regards to database duplication, the Courts have also stated that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

Furthermore, utilization of a switching node is old and well known in the art of information technology and telecommunications. It would have been obvious to one of ordinary skill in the art to have modified Eldering and Wagner by incorporating such components, devices and/or technologies that were conventional and/or standard in the



art of information technology and telecommunications at the time the invention was made.

Additionally, the concept of central delivery, receipt, storage and/or transmission of information between multiple parties through a central hub, such as a centralized database, is old and well known in the art. It would have been obvious to one of ordinary skill in the art to have modified Eldering and Wagner by incorporating the processing and/or storage of information on a central database, as is old and well known in the art, to capture the benefits of utilizing conventional and/or standard information technology topographies.

**Regarding Claims 9 – 14 and 21 - 34**, Claims 9 – 14 and 21 - 34 recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

As for additional and/or differing claim limitations, Eldering does not teach that the methodologies, protocols and/or practices are automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

### ***Response to Arguments***

Applicant's arguments filed 11/08/06 have been fully considered but they are not persuasive.

In response to applicant's arguments concerning Eldering, specifically applicant's assertion that Eldering fails to teach a server node with the same functionality as the instant applicant, Examiner respectfully disagrees.

Eldering does not teach a model "wherein a single seller auctions its advertising space to a plurality of buyers," but rather an electronic marketplace in which multiple "content/opportunity providers announce to advertisers that they have an opportunity to present an advertisement to a consumer." (see abstract).

Eldering does not operate in a manner "without requiring a server node to act as an intermediary" as the server is a separate entity from the content/opportunity provider (see. fig. 1A). Furthermore, even if such characterization of Eldering is correct, which the Examiner refutes, Examiner sees no claim limitation requiring that the server node must function as an intermediary.

While the seller in Eldering is the final decision-maker in regards to accepting a particular bid, such a distinction is outside the scope of the claims as originally presented. As originally presented, the server node matched requests and offers, which is the very function of Eldering. Eldering correlates the ad characterization information, designating the parameters of the advertiser's request, with the consumer profile, designating the parameters of the content/opportunity provider's media content in which to place such advertisements. (see abstract) The matching between the two "can be in

the form of demographic matching, product preference matching, or a combination of both." (see col. 2, lines 11 – 14).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

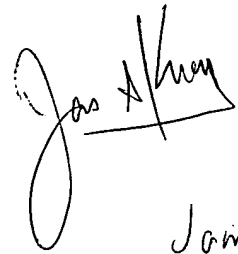
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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 2/5/07  
James Kramer